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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/066,005	<b>Applicant(s)</b> SCANCARELLA ET AL.	
	<b>Examiner</b> Gina C. Yu	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) 1-16, 24-37 and 51-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-23, 38-50 and 56-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 7, 2006 has been entered.

Claims 1-78 are pending, of which claims 1-16, 24-37 and 51-55 have been withdrawn from consideration due to the restriction and species election requirements made on April 23, 2003 and June 22, 2004, respectively. Claims 17-23, 38-50 and 56-78 are examined.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 17-23, 38-50, 56-78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 17, 44, and 66 recite, "wherein the wetting agent overcoat composition flows smoothly". The term "smoothly" in the claims is a relative term which renders the claims indefinite. The term "smoothly" is not defined by the claim, the specification does

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not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The remaining claims are rejected as depending on the indefinite base claim.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 17-19, 21, 23, 38-44, 46-50, 58, 59, 76 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drechsler et al. (US 6074654) (“Drechsler”) in view of Manufacturing Chemist, ExxonMobile Chemical Technical Data, and Litton (US 5970989).**

Drechsler discloses a method of enhancing the gloss, shine, and feel of lip composition by apply a complimentary product, known as “overcoat” or “topcoat”, over the film formed after application of a transfer-resistant lip composition. See col. 10, line 63 – col. 16, line 7. As for the film-forming coloring composition of instant claims 17 and 44, the reference teaches using (i) crosslinked organosiloxane resins such as Wacker 803 from Wacker Silicones Corp. (trimethylsiloxysilicate); (ii) volatile carriers, most preferably isododecane; and (iii) pigments. See col. 7, line 46 – col. 9, line 2. The reference also teaches in col. 2, lines 7-13 that it is well known in the art to formulate a transfer-resistant cosmetic composition with trimethylated silica and volatile solvent. Combining organic D & C pigments and inorganic titanium dioxide is taught in Example 3. See instant claims 49 and 50. The reference also teaches that the overcoating composition can be liquid or solid and include “any that are commercially available or to

be developed, provided the aggregate of the materials comprising the overcoat does not significantly disrupt" the film-forming composition. See col. 11, line 64 – col. 11, line 29; instant claims 38-40. Example 5 shows a composition comprising wax. See instant claim 41. Examples teach that the coloring film-forming composition and overcoating composition are stored in a separate lipstick cases. See instant claim 18. There is no teaching in Drechsler to use non-volatile silicone oil in the lip composition, thus the limitation that excludes non-volatile silicone oil from the wetting agent is met. Drechsler also meets claims 76 and 77, as the prior art overcoating composition does not employ mineral oil.

Drechsler fails to specifically teach using a liquid polymeric hydrocarbon with number average greater than about 650 to make the overcoating composition.

Manufacturing Chemist teaches that poly- $\alpha$ -olefins (notably polydecene) are "popular as oil-free emollients", which are used as "pigment wetting and dispersing aids and recommended as a replacement for mineral oil". See p. 2, Base Formulation Improvements, 3<sup>rd</sup> par. The teaching here would have motivated a skilled artisan to exclude mineral oil. See instant claims 76 and 77. These emollients are said to be "colourless, odourless, non-toxic and non-greasy and blend well with most cosmetic oils". See *Id.* The reference teaches that the products under PureSyn trademark from Mobil Chemicals and Arlamol brand by Uniqema are available in different viscosity grades. See instant claims 38-40. The refractive index of the wetting agent is a physical property of the polydecene and thus inseparable from the compound. See instant claim 42.

ExxonMobil Chemical teaches that PureSyn polyalphaolefins are hydrogenated hydrocarbon fluid. See claim 58. The reference teaches PureSyn 150 and 300 having a number average molecular weight of 3,500 and 5,100, respectively. See claim 59. The polyalphaolefins are "premium fluids whose features set them apart from other hydrocarbon fluids such as mineral oils, petrolatum, and polybutene"; "bright and clear, water-white, high-purity", "nongreasy" "nonoily", "nonirritating" "stable in low and high pH systems", and applicable in personal care formulations including cosmetics.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to have modified the invention of Drechsler by adding the hydrogenated poly- $\alpha$ -olefins such as polydecene as taught by Manufacturing Chemist and ExxonMobile Chemicals, because 1) Drechsler teaches that overcoating compositions enhance gloss, shine, and feel, and can be any commercially available composition which does not significantly disrupt the film-forming coloring composition ; and 2) Manufacturing Chemist and ExxonMobile Chemicals specifically teach that poly alpha-decenes are popular emollients in cosmetic art, colorless, odorless, non-toxic, and non-greasy. The skilled artisan would have had a reasonable expectation of successfully producing an overcoating lip-gloss composition with good emolliency and less greasiness. As for claim 44, the rheology of the composition obviously is present in the overcoating composition of the combined references.

The references fail to teach supplying the film-forming and overcoating compositions in a single stock unit.

Litton teaches that cosmetic products that are designed to be used together are well known in the art. The reference also teaches, "often it is desirable to apply cosmetic and then use various grooming devices to enhance the applied cosmetic". See col. 1, lines 12 – 29. The reference also mentions that such design allows consumers to carry items such as lipstick with lipliner products, which they would not otherwise. The reference teaches a makeup kit containing a reservoir for lip-gloss or lip gel; and a second compartment for "a product used with the lip gel, in this case a lipliner pencil". See col. 3, lines 8-23. As for claims 18, 19, 43 and 46, how the invention is handled or sold in the market does not further limit the "multipack cosmetic" (i.e., there is no structural limitation).

It would also have been obvious one of ordinary skill in the art to package the lipstick and complimentary overcoat products of the combined references into one single stock unit, as motivated by Litton, because of an expectation that consumers could conveniently carry the complementary overcoat composition along with the lip coloring composition.

**Claims 17-19, 21, 22, 38-44, 46-50, 56, 57, 76, and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drechsler in view of Finkenaar et al. (US 4935228) ("Finkenaar"), Amoco Technical Data and Litton.**

As mentioned above, Drechsler fails to specifically teach using a liquid polymeric hydrocarbon with number average greater than about 650 in the overcoating composition. With respect to the new claims 76 and 77, the Drechsler overcoating composition does not employ mineral oil.

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Finkenaur teaches lip-gloss composition comprising a mineral oil gel which comprising polybutene, a wear-enhancing agent. See Examples 2-5; instant claims 21 and 22. Also called "masking oil", polybutene is said to make "the lip gloss more water proof and permits it to retain its coloring and other beneficial effect on the wearer's lips for a substantially longer period", or up to 3 hours. See col. 3, lines 17 – 33. The reference teaches polyiso- and normal butenes supplied by AMOCO [sic] from INDOPOL, H-100, H-300, and 1500. See col. 4, lines 24 – 33. The lip-gloss composition is said to be a low pigmented, high shine lip preparation. See col. 1, lines 60 – 64. Finkenaur fail to teach the number average molecular weight of the polybutenes.

Amoco Technical Data teaches polybutene Indopol H-100 having number average molecular weight 940. The reference teaches that the polybutene is used in personal care products. See instant claim 57.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the overcoating composition of Drechsler by adding the polybutene of Finkenaur and Amoco, as motivated by the references, because 1) Drechsler teaches that overcoating compositions enhance gloss, shine, and feel, and can be any commercially available composition which does not significantly disrupt the film-forming coloring composition; and 2) Finkenaur and Amoco teach that polybutene having nMW 940 makes more water proof and longer-lasting lip gloss. The skilled artisan would have had a reasonable expectation of successfully producing an overcoating lip-gloss composition with enhanced waterproof and long lasting effects.



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As for claim 44, it is viewed that the rheology property of the composition obviously is present in the overcoating composition of the combined references. With respect to claims 76 and 77, since the combined teachings of the references would have motivated to incorporate to the Drechsler overcoating composition polybutene for its specific cosmetic benefits, no mineral oil is required. Thus claims 76 and 77 are met.

The references fail to teach supplying the film-forming color composition and overcoating compositions in a single stock unit.

Litton, discussed above, teach that it would have been obvious to produce products that are used to together in a single unit.

It would also have been obvious one of ordinary skill in the art to package the lipstick and complimentary overcoat products of the combined references into one single stock unit, as motivated by Litton, because of an expectation that consumers could conveniently carry the complementary overcoat composition along with the lip coloring composition.

**Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drechsler, Finkenauf, Amoco Technical Data, and Litton as applied to claims 17-19, 21, 22, 38-44, 46-50, 56, 57, 76 and 77 as above, and further in view of Nichols (US 6509009 B2).**

The combined references fail to teach makeup remover composition.

Nichols teaches the method of using a make-up remover composition immediately prior to, or after applying the lipcolor composition. See col. 6, lines 54 – 59; col. 12, line 44 – col. 13, line 29. See instant claim 20.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the makeup kit of the combined references by further incorporating makeup remover product, as motivated by Nichols, because of the expectation of consumer demands for convenience.

**Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over") Drechsler, Finkenaure, Amoco Technical Data, and Litton as applied to claims 17-19, 21, 22, 38-44, 46-50, 56, 57, 76 and 77 as above, and further in view of Chadfield et al. (US 3871543).**

The references fail to teach the material of which the container of the multipack cosmetic made.

Chadfield teaches that lightweight, medium impact styrene is well known in plastic art for its use in making cosmetic containers. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use styrene to make the multipack lip color cosmetic of the combined references, as motivated by Chadfield, because the latter teaches that lightweight medium styrene is conventionally used to make cosmetic containers. The skilled artisan would have had a reasonable expectation of successfully producing a lightweight container for the cosmetic compositions.

**Claims 60-75 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drechsler, Finkenaure, Amoco Technical Data, and Litton as applied to claims 17-19, 21, 22, 38-44, 46-50, 56, 57, 76 and 77 as above, and further in view of STN-Registry.**

Drechsler, discussed above, teaches that the organosiloxane resins used in the invention has  $R_3SiO_{1/2}$  and  $SiO_2$ , wherein  $R_3$  is C and the  $R_3SiO_{1/2}$  and  $SiO_2$  ratio is 0.7:1. See col. 7, line 47 – col. 8, line 6; col. 19, lines 49-60, Example 7. See instant claim 68. The reference teaches using the film forming silicone resin in the amount ranging from 10 to 95 %. See instant claims 69 and 70. Example 7 also contains dimethicone, which is a nonvolatile silicone oil having viscosity of 1000 cSt. The example also contains 10 % of Bentone Gel VS-5PC.

The combined references fail to specifically teach quaternized hectorite.

STN-Registry teaches that Bentone Gel VS –5PC contain quaternium-18 hectorite and cyclomethicone. See instant claims 60-62, 65, 66 (d), 71, 72.

It would have been obvious to one of ordinary skill in the art that the lip coloring composition of the combined references would contain quaternium-18 hectorite, because STN-Registry teaches that Bentone Gel VS-5PC contains the clay material and was commercially available and used in the lip coloring cosmetic at the time of the present invention.

#### ***Oath/Declaration***

Declaration filed under 37 C.F.R. 1.132, submitted on July 7, 2006, has been fully considered but does not overcome the obviousness rejections made in this case.

In the declaration, the basecoat and overcoat compositions as disclosed by Drechsler and Finkenaar, respectively, were prepared. Declarant states that it was difficult to apply the Finkenaar overcoat composition over the lips on which the Drechsler composition had been applied, because the Finkenaar composition “was a

thick, stringy gum that could not be easily spread". Declarant also states that the composition had a "very tacky surface" and was not an effective cosmetic composition.

Examiner takes the position that the declaration does not overcome the obviousness rejection made in this case. The obviousness rejection is made on the premises that a skilled artisan would have added polybutene to the overcoating composition of Drechsler, rather than applying the whole mineral gel composition of Finkenaur. Furthermore, the content of the declaration is purported to demonstrate whether the combined references can be physically incorporated, rather than to show unexpected, surprising and nonobvious results of the applicants' own invention. See MPEP § 716.

### ***Response to Arguments***

Applicant's arguments filed on July 7, 2006 have been fully considered but they are not persuasive in part, and moot in part in view of the new grounds of rejection.

Applicants argue that the proposed combination of Drechsler and Manufacturing Chemist is based on impermissible hindsight. Specifically, applicants assert that Drechsler and Manufacturing Chemist fail to teach emollients with lubricious feelings to make an overcoat composition. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In response, Manufacturing Chemist and Exxon Mobil Chemical teach the cosmetic benefits of poly-alpha-olefins, and according to Drechsler, there is no specific restriction as to what

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cannot be used as the overcoating composition. The motivation to take the advantage of the cosmetic benefits of poly-alpha-olefins in an overcoating composition is objectively found in the cited evidence, and not from applicants' disclosure. Thus, there is no improper hindsight involved in this case.

Applicants also refer to the declaration filed under § 1.132 and assert that the Finkenaur lip gloss composition containing polybutene results in a thick, sticky, and stringy gum. The argument is unpersuasive because, as indicated above in Declaration/Oath, the proposed rejection requires that only polybutene be incorporated into the overcoating composition of Drechsler, rather than employing the whole mineral gel composition in place of the overcoating composition of the primary reference.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Gina C. Yu  
Patent Examiner